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IN THE

Supreme Court of the United States

October Term, 1941

No. 323

MUNCIE GEAR WORKS and BRUNS &
COLLINS, INC.,

Petitioners,

vs.

JOHNSON BROTHERS ENGINEERING CORPO-
RATION and OUTBOARD, MARINE &
MANUFACTURING COMPANY,

Respondents.

REPLY BRIEF FOR PETITIONERS

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REPLY BRIEF FOR PETITIONERS

In a case such as this, in which the issues are few, simple and well defined, ordinarily there is no necessity, and little excuse for a reply brief. However, respondents' brief is so extraordinary in many respects that a short reply thereto is believed to be justified.

In the first place, the brief repeatedly characterizes assertions made therein as having been either *conceded* or *admitted* by petitioners (see pp. 4, 13, 25, 26, 46, 58) when, indeed, no such admissions or concessions have ever been made, and the alleged facts referred to have been vigorously disputed, and have been conclusively shown not to be so. A striking illustration of this will be found on page 4 of respondents' brief whereon there is quoted a statement

(characterized as a *concession*) made on page 5 of our main brief, as follows:

"Early in the development of the art 'cavitation' was recognized as an effect that it was desirable to overcome or eliminate."

Notwithstanding the fact that on the same page of our main brief we then proceeded to show that the remedy for cavitation was merely the use of an anti-cavitation plate, as was well known in the art, and was expressly recognized by the patentee, Johnson, to have antedated his alleged invention of the patent in suit (see footnote page 13 of our main brief), respondents isolate the quoted assertion and progressively build it up to a point where (on pages 13, 46 and 58 of the brief) it is advanced as an *admission* that some unstated "problem" existed in the art, and the further *admission* that "the art searched in vain for an answer to this problem". Indeed, respondents even go so far as to say (p. 46) that by that statement "Petitioners concede the entire art was trying to solve" this wholly imaginary problem. Contrary to this tortured argument, the only problem that ever existed was that of cavitation, and that problem was solved by the anti-cavitation plate—years before the Johnson patent in suit.

Another outstanding illustration of the extraordinary character of respondents' brief is the frequent and unwarranted use of the term "undisputed". Thus, it is asserted (p. 13) that it is "undisputed" that the production of "such" motors was not possible until Johnson showed the way; and (p. 31) that

"Johnson was the *undisputed* inventor of the subject matter of his patent".*

* Emphasis ours throughout.

We can conceive of nothing that is in greater dispute in this case.

Finally, on page 7 of their brief, respondents have prepared a drawing which is not an exhibit in the case. Allegedly it is "based on the testimony". In fact, however, it is not, and purports to show the existence of cavitation *despite* the use of an anti-cavitation plate—a proposition that is flatly contradicted by the patents of the prior art (R. 418, 482) showing the use of anti-cavitation plates (including a prior patent to Johnson himself). Of course, a drawing can be made to show anything—*e. g.* the *impossible* vortex paths shown. If a drawing of this character would have been supported by the evidence, it could and should have been made and produced as an exhibit in the case, and the ingenuity of its creation could have been tested by cross examination on the points of competency and accuracy—points which, obviously, have been ignored in this belated effort, induced by present exigency, to favorably interpret oral testimony.

In the final analysis, it is thought that a consideration of the merits of this case must start with a precise understanding of what is the "invention" of the Johnson patent, as defined by the four claims thereof (Nos. 11, 12, 13 and 14). On this there no longer can be any question. Although respondents seek to inject additional features into the subject, such as an alleged "balance" between the power used in propulsion and that wasted in slip stream (Brief, p. 8), and the "size" of the anti-cavitation plate (Brief, p. 9), neither of these features is mentioned or remotely suggested in the specifications or claims of the Johnson patent. Therefore, respondents are ultimately forced to the assertion (pp. 13, 45, etc.) that, simply stated, the invention consists of *combining old streamlining with the old anti-cavitation plate*.

Therefore, with a clear understanding of what respondents allege comprises the "invention" here involved, we proceed to our reply to respondents' arguments on the merits of the three points upon which our main brief predicated the plea for a reversal of the judgment of the Court of Appeals below.

POINT I.

The illegal amendment of the Johnson application.

The application for the Johnson patent was filed with no disclosure whatever of streamlining. Indeed, streamlining is not even now claimed by the patent, although the Court of Appeals interpreted the claims to be directed thereto. The word "streamline" occurs only once in the patent, on page 2, line 88 (R. 342), and this was introduced by the amendment of March 30, 1929 (Petitioners' Appendix, p. 40). All references in the patent to a smooth or unbroken housing wall were introduced at the same time. Of the four claims in suit, claims 11 and 13 do not even call for smooth or unbroken walls. Claim 12 calls for unbroken walls; and claim 14 calls for smooth and unbroken walls. Consequently, it will be seen that not even the slightest suggestion of streamlining appeared in the Johnson application until March 30, 1929.

Faced with this situation, respondents advance a number of contentions in the futile effort to escape its consequences. These will be treated separately.

1. It is asserted (Brief, p. 17) that our point of argument involves merely a charge of "delay" on the part of Johnson in claiming this subject matter, based on the assertion (subsequently made) that Johnson did disclose

streamlining *in the drawing* filed with his application. Thus do respondents seek to change our first point of argument from what it is to something which respondents would prefer to have it. We raise no question of mere "delay". We make the flat assertion that Johnson never disclosed in his application as filed on August 25, 1926, the "invention" which respondents now assert the Johnson patent to cover; and that no such disclosure, or claim directed thereto, was made until March 30, 1929—more than 2½ years thereafter, and more than 2 years after devices embodying the alleged invention, had been on the commercial market. These facts are not and cannot be denied.

The law applicable in such a case, and cited in our main brief, is clear and unequivocal. It is not in the least concerned with whether or not the drawings forming part of the application for patent, by some tortured interpretation, might be presumed to have illustrated the belatedly claimed invention. This is so because it is elementary that a mere illustration by a drawing does not comply with the statutory requirement for a *written description* in the specification (*Permutit v. Graver*, 284 U. S. 52).

However, in this case the Johnson drawings do not disclose a streamline structure in any sense. So far as is illustrated in the drawings, the housing could be *rectangular*, and there is nothing in the specification, other than the single word "streamline" (introduced in 1929) to indicate any shape *other than rectangular* for the housing. If the housing were rectangular it could still have unbroken outer wall surfaces (claim 12) or smooth and unbroken walls (claim 14) but it would not be "streamline". To the contrary, it would offer ~~maximum~~ resistance to the passage of the structure through the water, and defeat the very purpose of streamlining. It is obvious, therefore, that the Johnson drawing—either as filed with his application or

as issued in the patent—does *not* disclose the alleged “invention” now argued for the patent. If Johnson had intended to disclose in his drawing a “streamline” housing, or even a *circular* housing, he would have done it in one of the conventional ways, such, for example, as used in Johnson Patent No. 1,736,970 (R. 346), that is, by appropriate shading as in Figure 1 of that patent, or by cross-sectional views as in Figures 5 and 6 (R. 348). These are standard drafting practices (see, for example R. 314, 322, 328, 334, 360, 382, 396, 398, 406, 418, 422, 426, 495, 502, 504, 506, 518, 526, 534, 552, 556, 573).

From this it becomes conclusively apparent that the subject of “streamlining” was entirely an “afterthought” on Johnson’s part (Cf. *Simpson v. Newport News Shipbuilding & Drydock Co.*, 18 Fed. (2d) 318, 323; affirmed, C.C.A. 2nd, 18 Fed. (2d) 325; *United Wireless Telegraph Co. et al. v. National Electric Signaling Co.*, 198 Fed. 386, C.C.A. 1).

2. Respondents next assert that Johnson complied with the rules of the Patent Office in the prosecution of his application. This, of course, is not the fact. Rule 70 of the Patent Office, quoted on pages 25 and 26 of respondents’ brief, prohibits the insertion of *new matter*, and requires that matter *not* disclosed in the application as filed shall be claimed only in a separate application. Such a separate application filed by Johnson on *March 30, 1929*, would have been *totally invalid* because of the statutory bar raised by the commercial production and sale of the Johnson (and other) motors more than two years prior to that date. Johnson accordingly attempted to circumvent the statute and the rules of the Patent Office by adding new matter in the word “streamline” and all that respondents *now* assert that word implies, and was successful in persuading the

Court below to hold that claims 11 and 13 (which are completely silent on the subject), and claims 12 and 14 (which define only smooth and unbroken walls) were directed to streamlining.

3. The issue here presented is not, as respondents seem to argue (*e. g.* Brief p. 20) that of "intervening rights" as that term has been judicially defined. To the contrary, it is the legal consequence of a glaring attempt

" * * * to enlarge the scope of an application once filed * * * to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use" (*Chicago and N. W. R. Co. v. Sayles*, 97 U. S. 554, 563).

Therefore, whether or not petitioners engaged in the outboard motor business only after the patent was issued in 1929, is wholly immaterial. It is likewise immaterial how long a period elapsed between the filing of the Johnson application and the illegal amendment presenting a new and different statement and claim of invention. The only material fact is that Johnson's altered statement and claim of invention were made *after* outboard motors described thereby had "gone into public use". The fact, here present, that the illegal amendment was made *more than two years* after such public use, established a statutory bar to the validity of *any* patent that might have issued on the new statement and claim of invention (Section 4886 R. S.) *.

4. Respondents argue (Brief, p. 29)—as though it made a difference, which it does not—that claims 20 to 25, which do not include the deflection plate or its arched support, were filed in the Johnson application on December 8, 1928—

* Section 4886 R. S. is reproduced in full at the back of this brief.

2 years and 4 months after the application was filed—and, therefore, the alleged "delay" with which they charge themselves is 3 months shorter than that which would be attributable to them if held to the date (March 30, 1929) when they presented the "streamline" amendment to the Johnson specification. Of course, we are not concerned with the question of "delay", nor with what other definitions of Johnson's invention may have been asserted. We are only concerned with when Johnson first mentioned or claimed the subject of streamlining in his application. Undeniably and undeniably, *that was on March 30, 1929*—more than 2½ years after his application had been filed, and more than 2 years after outboard motors incorporating what is now alleged as the invention were on the commercial market. While it is true that claims 20 to 25 submitted to the Patent Office on December 8, 1928, did not mention the deflection plate or its arched support, it is equally as true that they did not mention the streamline feature. They comprised merely an aggregational catalogue of the parts making up an outboard motor assembly, with *nothing* of novelty even suggested. The utter impropriety of these claims was quickly recognized by Johnson's solicitor, because they were cancelled on March 30, 1929, without even affording the Patent Office Examiner the opportunity of rejecting them (Brief, p. 19).

5. Respondents repeatedly assert that the issue of the illegal amendment is raised in this Court for the first time (Brief, pp. 17, 35), and devote pages 36 to 39 of their brief to a discussion of this subject. As part of their argument, respondents quote (on pages 36 and 37 of their brief) from the fourth defense pleaded in the answer, and a portion of the argument of petitioners' brief in the Court of Appeals below. These quotations, alone, completely and dispositively answer respondents' arguments on this subject.

POINT II.

The invalidity of the Johnson patent because of aggregation.

Respondents insist (Brief, p. 39) that this issue "is a question of fact". If so, then the trial court's *finding* of fact that the Johnson patent is invalidly aggregational (Opinion, R. 243-244; Finding of Fact 6 (e), R. 293; see also Conclusion No. 1, R. 296) should have been regarded as "unassailable" by the Court of Appeals (*Adamson v. Gilliland*, 242 U. S. 350). The failure of that Court to do so, alone should warrant a reversal of its judgment..

However, respondents' arguments that there is patentable coordination in combining the old cavitation plate with an old streamline housing for an outboard motor shaft, is so transparent and devoid of merit that we cannot refrain from brief comment upon them.

It would seem to be clear, beyond argument, that all and the most that an anti-cavitation plate can do is to prevent cavitation; and that all that streamlining can do is to reduce resistance, by the outboard motor structure located beneath the surface of the water, in moving through the water, and avoid eddy currents or turbulence behind the moving body. Each, necessarily, must perform its individual function, regardless of whether or not the other is present. Realizing this, respondents make the most extravagant assertions. Thus, it is asserted that the result obtained by combining these two old features "is a wholly new result" (Brief, p. 44); and that the smooth walls or streamline "perform a new function". The absurdity of these assertions is believed to be apparent. But the invalidity of the claims because of aggregation is not alone

because of the lack of any patentable combination between these two features. To the contrary, and as pointed out in our main brief on this subject (pp. 17 to 19), invalid aggregation is present, between *each* of these two features, and *both* of them combined, with *all* of the *other* elements of an outboard motor assembly catalogued in the claims in suit.

Moreover, respondents' cause is aided not at all by the repeated assertion (*e. g.* p. 42) that *smaller* anti-cavitation plates can be employed in the aggregational combinations recited by the claims. If, indeed, that is a fact, or a feature of Johnson's invention, the Johnson specifications and claims are wholly silent with respect thereto.

It is obvious, therefore, that the Johnson claims are invalidly aggregational.

POINT III.

Anticipation and want of invention.

Respondents urge (pp. 17 and 45) that this Court should not consider this issue because, assertedly, it was not mentioned in the petition for writ of certiorari. In this respondents are in error. The prayer of the petition specifically recites (p. 8), as among the matters for which a review by this Court was solicited, "the questions of anticipation and invention" (see also Specification of Errors No. 4, p. 12 of the Brief on the Petition).

In view of this Court's recent decision in *Cuno Engineering Co. v. Automatic Devices Corp.*, 314 U. S. —, wherein what is required to constitute "invention" is so clearly set forth, as well as the reasons, from the viewpoint of the public interest, why a *substantial* advance must be

made by a patentee in order to justify burdening an industry with the heavy hand of patent tribute, it is believed no further argument on this subject is here required. However, we cannot refrain from again commenting upon the extravagant and wholly unwarranted assertions of respondents that "the art had long recognized the problem but without finding a solution", and that "the entire art was trying to solve" such a problem (Brief, p. 46). Any "problem" that may have existed was purely imaginary or fictitious. Even more so was any alleged effort by the industry to "solve" any such problem. Respondents' brief cites no evidence in the case to support the assertions. It is based solely on the wholly unwarranted and tortured interpretation of the sentence on page 5 of our main brief, isolated from its context, as already has been exposed herein (*ante*, p. 2).

Conclusion.

Streamlining, as the Court knows, is the current vogue. Everything from baby carriages to ocean liners is streamlined. Consequently, there is little if any market for anything that moves, unless it is streamlined. This, then, is the invention of the Johnson patent; not that it taught anything, not that it advanced or changed the art in any way, but that, as interpreted by the Court of Appeals, it capitalized market caprice. Anti-cavitation plates are necessary for efficient performance, but the patents on them have long since expired. Streamlining is necessary for sales appeal. So, a patent on the obvious *combination* of these two old features is advanced as a justification for laying the heavy hand of tribute on an entire industry, even though that combination of those two old features was not shown, described, or claimed as the alleged invention of the appli-

cation for patent until years after outboard motors utilizing that combination had been on the commercial market. In other words, the only "invention" that has been made in this case was the idea of altering the Johnson application so as to permit it to be utilized in an attempt to dominate commercial structures to which Johnson had contributed nothing.

The Judgment of the Court of Appeals should be reversed.

Respectfully submitted,

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APPENDIX.

*Section 4886. (U. S. C., title 35, sec. 31). Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. **

* Emphasis ours.